

REMARKS

Claims 1-5, 7-14 and 36-49 are pending in this present application. Claims 15-35 are withdrawn from consideration as being drawn to a non-elected invention, and claim 49 has been added. Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action of October 3, 2006, the Examiner rejected claims 36-48 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Additionally, the Examiner rejected claims 1-5 and 7-14 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,849,149 (hereinafter "Otaki") in view of U.S. Patent No. 4,893,877 (hereinafter "Coates").

Rejection under 35 U.S.C. § 112, first paragraph

Claims 36-48 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner argues that "there is not support in the specification for image free metallic layer." See Office Action, page 2, para. 3.

Compliance with the written description requirement is a question of fact and is to be determined on a case-by-case basis. See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116 (Fed. Cir. 1991). Regarding new or amended claims, the MPEP notes that "[w]hile there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." See MPEP § 2163. Further, the fundamental inquiry is "whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed." Id. Regarding determining the adequacy of written description, the Examiner is to "review the claims and the entire specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention." Id.

In amending or adding claims, the Applicant is to show support by specifically pointing out the support within the original disclosure. See MPEP § 2163.06. If the Applicant has amended or added claims and pointed out "where and/or how the originally filed disclosure supports the amendment(s)," and the Examiner is not satisfied that the

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disclosure “reasonably convey[s] that the inventor had possession of the subject matter” when the application was filed, then the MPEP notes that “the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” See MPEP § 2163.04.

In the Request for Continued Examination (RCE), filed on September 21, 2006, the Applicant presented new claims 36-48. Along with the new claims, the Applicant specifically noted: “New claims 36-48 are supported by Fig. 1 and Fig. 2, along with page 7, lines 1-20, and claims 1-13 as originally filed. Note particularly that all imagery is noted on the figures (at 12), which is printed on the printable layer. In other words, as images are actually shown in the figures where present, other locations where no images are shown provide support for the lack of said images.” In response to the newly added claims, the Examiner alleges that the claims “contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention.” See Office Action, page 2, para. 3. Applicant respectfully disagrees. Further, Applicant argues that the Examiner has failed to present “evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the [newly added] claims”.

Regardless, Applicant will further outline the support for the newly added claims, show that the Applicant possessed the claimed invention at the time of filing the applicant and further detail why one of ordinary skill in the art would recognize, in the disclosure as originally filed, an image-free metallic layer.

As originally cited by the Applicant, the included Figures 1 and 2 show a “cross-sectional view of an embodiment of the present invention” and a “cross-sectional view of a durable composite material formed from the materials of FIG. 1 according to an embodiment of the present invention” respectively. See Application, page 3, lines 3-8. The specification notes that the figures are not drawn to scale, however does not in any place state or infer that the embodiments, as presented in the figures are incomplete in their composition. This is important because an image, 12, is very clearly marked and defined in both figures, and is thoroughly discussed in the specification. The image, 12, is attached to the printable layer, 10 in FIG. 1, and is sandwiched between the printable layer 10, and an adhesive layer, 18, in FIG. 2. The metallic layer, 14, is present in both figures, and is only in contact with an

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adhesive layer 18, and a protective layer 16. The specification explains these relationships and is consistent with the Figures. See Application page 5, line 13, through page 12, line 17. There is no image in direct contact with the metallic layer in the Figures, nor is there any discussion in the Specification about having an image on the metallic layer. Where such discussion has been made in articulating and further illustrating the location of an image, it would be difficult to say that (1) the Applicant did not possess the invention at the time of filing, or that (2) one of ordinary skill would not recognize that an embodiment of the present invention includes an image-free metallic layer.

Furthermore, one of ordinary skill in the art would recognize by the discussion on the metallic layer that one of the aspects of the invention necessarily includes an image free metallic layer. The majority of the noted methods of forming the metallic layer would not inherently, and in some cases, may not possibly form a metallic layer with an image. The specification notes physical vapor deposition, electrodeposition, electroless deposition, and extrusion. See Application page 7, lines 15-22. One of ordinary skill in the art would not be lead to believe that this teaches an imaged metallic layer, and therefore can clearly teach an image-free metallic layer.

Therefore, as the newly added claims are fully supported in the Application as originally filed, the Application shows possession of the claimed subject matter at the time of filing, and one of ordinary skill in the art would recognize that the Application teaches that the metallic layer can be image-free, the Applicant respectfully requests withdrawal of the rejection and allowance of claims 36-48.

Rejection under 35 U.S.C. § 103(a)

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. Further, the Examiner has to establish some suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. The Applicant respectfully asserts that the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

Claims 1-5 and 7-13

The Examiner rejected claims 1-5 and 7-14 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,849,149 (hereinafter "Otaki") in view of U.S. Patent No. 4,893,877 (hereinafter "Coates"). Claim 1 has been amended to require that the printable layer include an ink-receiving layer. As previously noted, this amendment is fully supported in the Application as originally filed and such limitation is not found in the cited references. Therefore, removal of the rejection is respectfully requested.

Claim 14

A *prima facie* case of obviousness has not been presented for claim 14 for lack of teaching of each and every element of the claim. Specifically, neither Otaki nor Coates teach a foil. A metallic foil, as commonly known, is a thin sheet of self-supporting metal. Claim 14 specifically claims a metallic foil layer. Otaki teaches only a hologram. Coats, on the other hand, teaches metallic holograms comprising a thin layer of metal which is always adhered to or deposited on a substrate. Unlike the claimed foil, the metallic layer of Coats is necessarily very thin and is fabricated or deposited on a die or substrate which is then used for transferring purposes. The methods of Coates, such as sputtering and vacuum depositing the thin layer of metal, would not create a foil. The metal layers of Coates are not layers of self-supporting metal.

The Examiner argues that because Coates teaches a thickness of the metal hologram of 0.02-0.1 μm , and the present application teaches metallic foils having thickness of 0.01 to 5 μm , that Coates necessarily teaches a foil as claimed. This is not so. Regardless of the thickness of the metallic or hologram layer, a metal foil is a layer which is independent and self-supporting. The procedures and methods taught in Coates necessarily prevent formation of a metal or holographic layer which is either independent or self-supporting. As such, Coates can not teach a metal foil. Thickness can be an aspect of the metal foil, however depending on the materials used, some thicker layers may be ineffective at self-supporting, whereas thinner layers of other materials may be independent and self-supporting. Therefore, the thickness of the layer does not determine whether or not a metallic layer is considered a metallic foil.

As neither Coates nor Otaki teach a metallic foil layer, they do not teach each and every element either alone or in combination. Therefore, withdrawal of the rejection is requested.

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It is respectfully submitted that the rejections of the presently pending claims be reconsidered and withdrawn and that all claims be allowed. In view of the foregoing, Applicants believe that claims 1-5, 7-14 and 36-49 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025

Dated this 3rd day of January, 2007.

Respectfully submitted,



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